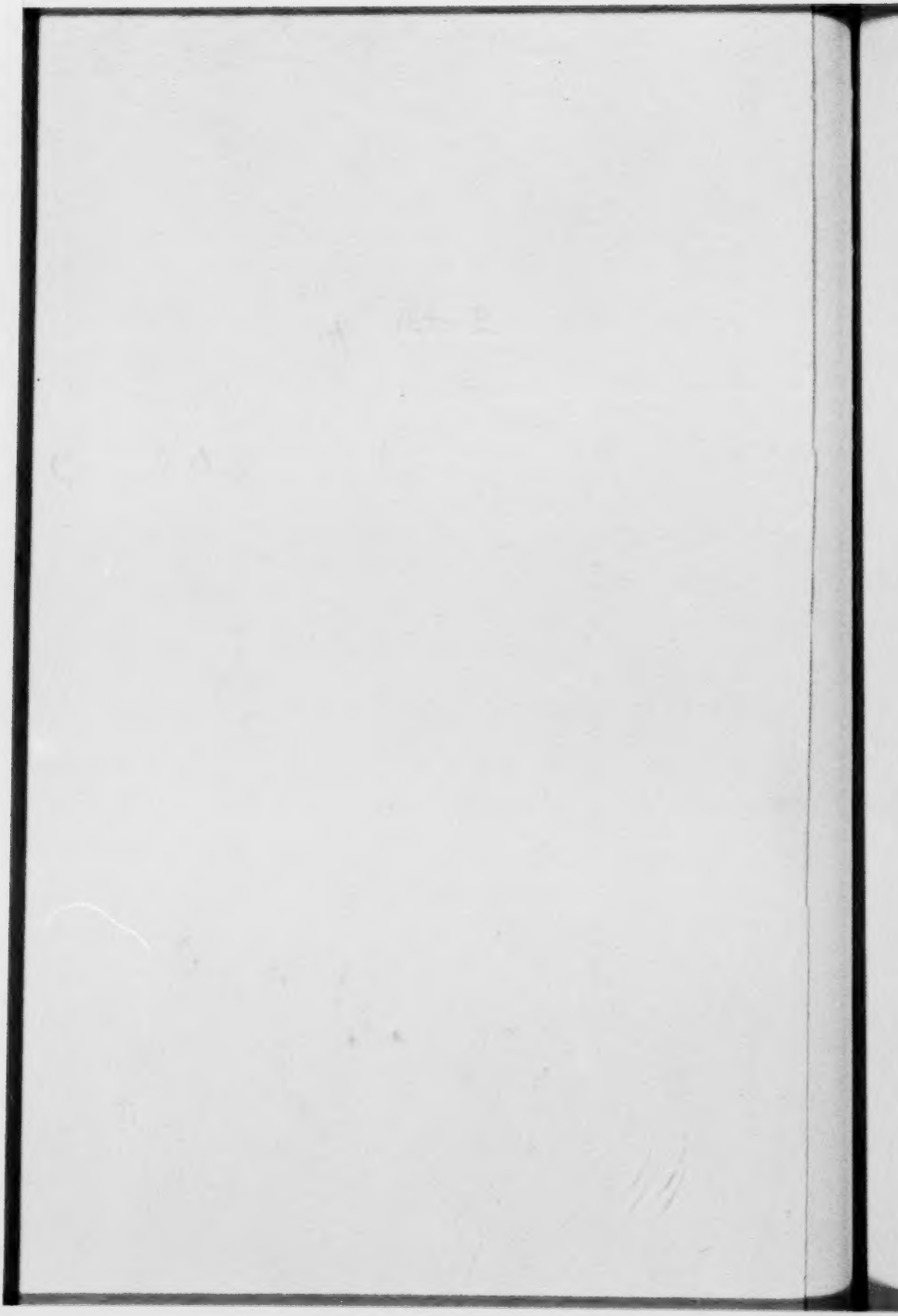

IN THE

Supreme Court of the United States

TERM.

CUTLER MAIL CHUTE COMPANY, Petitioner, Plaintiff and Appellee below, against CAPITOL MAIL CHUTE CORPORATION, Respondent, Defendant and Appellant below.	No.

BRIEF IN SUPPORT OF PETITION.

In Support of Jurisdiction.

I.

There were no concurrent findings by the courts below as to the claims in issue.

The District Court considered in its opinion *all* of the claims in suit, namely nine claims (Tr. pp. 221 to 223), and these were reproduced in the Findings of Fact (Tr. pp. 243 to 246).

But the Court of Appeals apparently only considered claim 2, since it stated: "It will suffice to quote claim two which reads as follows:

> 2. The combination with a mail chute having
> a mail receiving aperture and
> a passage leading therefrom to the interior of the chute and with

a delivery aperture below the first named aperture adapted to discharge exteriorly of the chute, there being communication between said passage and the discharge aperture, of

a weighing device operating in the passage to normally direct light foreign matter deposited in the mailing aperture to the delivery aperture but adapted to be displaced by mail matter and permit its passage to the chute."

However, other claims embrace a different structure, as is evident from claim 8, as an example:

"8. The combination with a mail chute having

a mail receiving aperture leading to the interior of the chute and

a delivery aperture below the same adapted to discharge exteriorily of the chute, of

a device arranged between the two apertures adapted to block access (see 18 in Figure 4, and 24 on Figure 8, in the patent in suit Tr. pp. 74-75) of usual mail matter inserted through the upper receiving aperture from passage to the lower discharge aperture while permitting passage of small objects, such as litter similarly introduced to and through the discharge aperture."

The decision of the lower court is based upon *all* of the claims in issue. The decision of the Court of Appeals refers only to claim 2 and it grounded its conclusion upon elements forming only part of a single claim in suit. There were no concurrent Findings by the Courts below as to the claims in issue. The applicable principle is stated

in the case of *Altoona Pub. Theatres* v. *American Tri-Ergon Corp.*, 294 U. S. 477:

> "While both courts below have found invention and sustained the patent, the Court of Appeals as will presently appear in more detail, *did not pass on the separate claims in issue,* but found invention in a combination of elements not embraced in any single claim. In consequence, *the case presents no question of concurrent findings by the courts below* that the claims in issue severally involve invention." (Italics supplied.)

II.

There is no possibility of obtaining a conflicting decision in a court of another appellate jurisdiction.

All of Petitioner's competitors have respected the patent in suit since its issuance on May 9, 1933, save this defendant, and no installation save the one sued on in this case has been made by this defendant. Petitioner has no one to sue in any other Judicial Circuit in the hope of bringing about a conflict of decisions. It is confronted with the immediate necessity of filing a disclaimer. (*Ensten* v. *Simon A. Co.*, 282 U. S. 45; *Altoona Pub. Theatres* v. *Am. Tri-Ergon Corp.*, 294 U. S. 477; *Triplett* v. *Lowell*, 297 U. S. 638.)

Only the Defendant made the accused structures in this case, and mainly by hand, and installed them only in one building and made no offer of any such structures to any one else in the trade. The present economic conditions have suspended or limited the requirement of mail chutes with this patented device therein. In consequence, as no one else is making or selling in another judicial

circuit a structure such as to be an infringement, there is no possibility of obtaining a conflict of decisions in another appellate court.

Petitioner appears to be in exactly the same position as the plaintiff in *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U. S. 49. In that case it was said:

> "Litigation elsewhere with a resulting conflict of decision was improbable because of the concentration of the automobile industry in the sixth circuit."

Unless this court grants relief, all of the present claims in suit of plaintiff's patent will have to be disclaimed, thus rendering the patent in suit a nullity, although all the *claims* have not been held specifically invalid by the Court of Appeals.

III.

Section 240a (U. S. C. 28, sec. 347) provides:

> "In any case civil or criminal, in a Circuit Court of Appeals, or in the U. S. Court of Appeals for the District of Columbia, it shall be competent for the Supreme Court of the United States, upon the petition of any party thereto, whether Government or other litigant, to require by certiorari, either before or after a judgment or decree by such lower court, that the cause be certified to the Supreme Court for determination by it with the same power and authority, and with like effect, as if the case had been brought there by unrestricted appeal."

In Support of the Reasons.

1.

The findings of fact should have been considered as unassailable under R. C. P. 52.

The pertintent Findings of Fact of the District Court as to the Teevan Patent not referred to by the Court of Appeals, read as follows:

> "The principal object of the invention (of the prior Teevan Patent) was to prevent the surreptitious extraction of the contents of the box. (Tr. p. 248) * * * but that is in no sense the type of trap of the patent in suit. (Tr. p. 248) * * * The letter flap of Teevan does not intercept, divert and discharge away from the 'letter passage', the litter injected into a mail chute. It was not intended to work that way, and as shown cannot work that way. (Tr. p. 249) * * * The Teevan Patent * * * did not teach the use of the letter flap to intercept, divert, and discharge away from the 'letter passage' the litter injected into a mail chute." (Tr. p. 250.)

Unless these were shown to be "clearly erroneous", these should have been accepted as premises by the Court of Appeals.

> "* * * that findings must be sustained if there is any 'substantial evidence' to support them. Rule 52a of the Federal Rules of Civil Procedure provides:
>
> > 'Findings of Fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the

credibility of the witnesses'." *Anglo-California Nat. Bank* v. *Lazard,* 106 F. (2), 693, 706 (C. C. A. 9).

"The provisions of the new procedural rules that the Findings of Fact of the trial judges are to be accepted on appeal unless clearly wrong is but a rule long recognized and applied by Courts of Equity." *Guilford Const. Co., et al.* v. *Biggs,* 102 F. (2), 46 47 (C. C. A. 4).

"While it is true that on an appeal in equity a case is to be examined on both the law and the facts, and the reviewing court is not bound by the trial judge's Findings of Fact, it is equally true that the Appellate Court ought not to disturb such findings especially where the evidence is conflicting and the credibility of witnesses is involved, unless it appears that the trial judge was clearly wrong." *Malloy* v. *New York Life Insurance Co.,* 103 F. (2) 439 (C. C. A. 1).

"So far as the findings of the master or Judge who saw the witnesses depends upon conflicting testimony or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable." *Adamson* v. *Gilliland,* 242 U. S. 350.

Also: *U. S.* v. *Esnault-Pelterie,* ~~229~~ 299 U. S. 201; 303 U. S. 26.

2.

***Ex post facto* wisdom obtained from a patent cannot be used to reconstruct a prior art structure.**

The District Court considered the prior art as it is in accordance with settled law:

> "When it is sought to ascertain the state of the art by means of prior patents, nothing can be used except what is disclosed on the face of these patents." (*Naylor* v. *Aslop Process Co.* 168 Fed. 911, at 920 C. C. A. 8.)

But the Court of Appeals reconstructed the prior art Teevan patent in the light of the teachings of the patent in suit. The claims in issue are always the keystone from which the reasoning in every patent suit must begin. Instead, the Court of Appeals having in mind the patentee's solution of the problem, applied this to the forty year old still-born patent to Teevan, without recalling that "nothing is easier in patent litigation than to confuse a trifling physical change with the ingenuity demanded for its discovery." (*The Refractolite Corporation, et al.* v. *Prismo Holding Corporation, et al.*, C. C. A. 2, decided February 24, 1941, unreported). When the Court of Appeals stated: "To space more widely apart the two lowest bars of the grid and to slant the hinged flap C so that it would divert the trash into the opening rather than serve as a shelf upon which it could gather * * *", it reconstructed the old Teevan patent in the light of the patent in suit and in doing this, admitted, in effect, that the Teevan patent as it is did not anticipate (Tr. p. 279).

The Court of Appeals furthermore used neither the Findings of Fact, nor the claims in suit, as premises,

for its reasoning to define the invention in issue but set up a structure which it thought the patent in suit was, when it said that: "Van Riper's claim to invention must rest upon the mechanical changes which should be required to adapt the Teevan structure for use in a mail chute," (Opinion of C. C. A. Tr. p. 279).

The principle thereby established, will enable any defendant in a patent suit to assert, that the trier of facts can now reconstruct a prior art structure in the light of the knowledge obtained from the patent in suit then under consideration. No patent can remain valid under such conditions.

3.

The claims in suit are distinct combination claims and the Court of Appeals should have applied the law applicable thereto as did the District Court.

A combination of old mechanical parts is valid if it produces a new result, such new result of the conjoint action of the parts setting into being a new energy. A combination in point of law is valid if its entirety, in distinction to its parts, is not found as an entirety in the prior art, and is infringed, if that entirety is found in the accused structure.

In the Findings of Fact which have not been disturbed by the Court of Appeals, it appears:

> "While it is true that some of the elements of the combination of the claims of the patent in suit are old, and some old elements are found both in the Teevan Patent and in the patent in suit, the combinations in the patent in suit and in the Teevan Patent are different, function differently, and the combinations of the patent in suit produce a new and useful result over the Teevan patent structure." • • •

> "By the law of structure of the Teevan patent is presented a co-action of parts totally different from the co-operative law of the patent in suit. Defendant praises the Teevan patent, and compliments the patent in suit by imitation." (Tr. p. 249.)

All of the claims in suit are "combination" claims.

A combination claim is valid unless anticipated by the same entirety or combination. (*Parkes* v. *Booth,* 102 U. S. 96, 104.) This rule requires a comparison of the claims of the patent in suit with the alleged prior art, not in regards to the elements composing the combination, but in regards to the co-operative law or entirety set into being or created by the patented combination. (*Seymour* v. *Osborne,* 11 Wall. 516; *Curtis on Patents,* p. 118, Sec. 111a, fourth edition.)

Under this rule the District Court properly held, as shown in the above quoted Findings of Fact, that the Teevan patent did not anticipate because it did not present the same entirety or co-operative law.

The Court of Appeals disregarded this rule. Any future defendant in a patent case can now contend in the Second Circuit that the Court of Appeals having quoted the combination claim, it is sufficient to find only *some* of the elements in the prior device and not all of the elements in the combination, thus in conflict with the law of this Court. (*Parkes* v. *Booth,* 102 U. S. 96, 104.)

There are cases of this court stating what a combination is not, such as *Hailes* v. *Van Wormer,* 20 Wall. 353, *Reckendorfer* v. *Faber,* 92 U. S. 347 and *Pickering* v. *McCullough,* 104 U. S. 310.

There is today a sharp conflict as to the law of combinations. Certain decisions hold that a combination to be valid must produce "a new result"; there are other cases holding that a combination may be valid if it produces an old result "in a more facile, economical and efficient manner."

Typical of the foregoing "novel result" cases are the following: *Seymour* v. *Osborne,* 11 Wall. 516; *Gould* v. *Rees,* 15 Wall. 187; *Fuller* v. *Yentzer,* 94 U. S. 288, 297; *Palmer* v. *Corning,* 156 U. S. 342; *Leeds & Catlin Co.* v. *Victor Talking Machine Co.,* 213 U. S. 301; *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.,* 220 U. S. 428. These cases support the view of Judge Evans of the Seventh Circuit in *Hartman F. & C. Co.* v. *Banning* (C. C. A. 7) 59 F. (2) 29, which required a new result.

Cases of an old result "in a more facile, economical and efficient manner" are all those of Judge Sanborn who initiated this doctrine in the Eighth Circuit: *National Hollow B. B. Co.* v. *Interchangeable B. B. Co.,* 106 Fed. 693, 707 (C. C. A. 8); *Kinloch Telephone Co.* v. *Western Elec. Co.,* 113 Fed. 659, 665 (C. C. A. 8); *Ide* v. *Trorlicht, Duncker & Renard Carpet Co.,* 115 Fed. 137, 141 (C. C. A. 8); *Anderson* v. *Collins,* 122 Fed. 451, 459 (C. C. A. 8); *Ottumwa Box Car Loading Co.* v. *Christy Box Car Loading Co.,* 215 Fed. 362, 369 (C. C. A. 8); *New York Scaffolding Co.* v. *Whitney,* 224 Fed. 452, 456 (C. C. A. 8); *Minneapolis, St. Paul & S. S. M. Ry. Co.* v. *Barnett & Rec. Co.,* 257 Fed. 302, 307 (C. C. A. 8).

In this last named case, and in some of the others of Judge Sanborn, *Seymour* v. *Osborne,* 11 Wall. 516 and *Rees* v. *Gould,* 15 Wall. 187, are relied upon to support this doctrine, but Mr. Justice Clifford carefully refrained from so expressing himself. In *Galvin Mfg. Co.* v. *Emerson,* 19 F. (2) 885, 890 (C. C. A. 8), Judge Phillips followed this rule of "more facile, economical and efficient manner" and then sitting in the Tenth Circuit again followed it in *Stearns Roger Mfg. Co.* v. *Ruth,* 62 F. (2) 442, 446 (C. C. A. 10). In *General Electric Co.* v. *Maytag,* 100 F. (2) 218, 221, Judge Gardner of the Eighth Circuit followed it. It will be noted that this doctrine prevails in the Eighth Circuit, and though questioned by Judge Evans in the Seventh Circuit as before shown, it is now

being applied therein, as recently as in *Safway Scaffolding Co.* v. *Patent Scaffolding Co.*, 110 F. (2) 1008. (Certiorari denied.)

The cases of Judge Sparks of the Seventh Circuit citing *N. Y. Scaffolding Co.* v. *Whitney*, 224 Fed. 452 (C. C. A. 8), in support of an old result in a more facile, etc., manner, are *Young Radiator Co.* v. *Modine Mfg. Co.*, 55 F. (2) 545 (C. C. A. 7); *Iron Fireman Mfg. Co.* v. *Industrial Engineering Corp.*, 89 F. (2) 904 (C. C. A. 7); and *Safway Steel Scaffolding Co.* v. *The Patent Scaffolding Co.*, 110 F. (2) 1008 (C. C. A. 7).

In the *Iron Fireman* case, 89 F. (2) 904, as showing the conflict, Judge Sparks said, Judge Evans also sitting:

> "We do not regard this holding as inconsistent with that of *Hartman F. & C. Co.* v. *Banning*, for in that case there was neither a new result nor *an old one performed more efficiently.*" (Italics supplied.)

In the case at bar, each claim is denominated as a combination. The Court of Appeals should have made these combination claims the keystone premise of the entire case, and should have also decided the case on combination law principles as was done by the District Court. (For a sharp application of combination law, see *Westinghouse Elec. & Mfg. Co.* v. *Cutter Elec. & Mfg. Co.*, 143 Fed. 966 [C. C. A. 3]; *Westinghouse Elect. & Mfg. Co.* v. *Condit Elec. Mfg. Co.*, 167 Fed. 546 [C. C. A. 2]; *Westinghouse Elec. & Mfg. Co.* v. *Cutter Elec. & Mfg. Co.*, 169 Fed. 634 [C. C. A. 3]; and *Fuller* v. *Yentzer*, 94 U. S. 288, 297.)

The present situation in the Second Circuit is none too clear as appears from the following excerpt, which might have been quoted in full, but for brevity is only indicated. It is submitted that there is confusion between what a combination is, and whether it is patentable:

> "We have not dealt with the defendant's argument that the first patent is for an 'aggregation.' Frankly, we are unable to attach a definite meaning to that word. * * * Therefore, we can find little advantage in a discussion of what is or what is not an 'aggregation.' * * * We had best abandon it." *Sacks* v. *Hartford Elec. Supply Co.*, 47 F. (2) 743, 748 (C. C. A. 2).

As an aggregation is the opposite to a true combination, the definition of aggregation assists in determining the meaning of combination. See *Hailes* v. *Van Wormer*, 20 Wall. 353. Is an "old result in a more facile, economical or efficient manner," an aggregation or a combination?

4.

The national importance of the law of combinations to industry should induce this court to set this conflict as to what a true combination is at rest.

The time consuming and painstaking preparation of Findings under R. C. P. 52, is rendered useless if the findings are not considered by the Appellate Court.

The doctrine of reconstructing or reorganizing a prior patent not designed nor intended for that purpose in the light of the teachings of the patent in suit, if made permanent, would undermine the Patent Act.

Respectfully submitted,

C. P. Goepel.

New York, March 31, 1941.